



PATENT
Customer No. 22,852
Attorney Docket No. 5638.0018-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Jörg BERNARD et al.) Group Art Unit: 1761
Application No.: 10/088,602) Examiner: L. Wong
Filed: August 23, 2002)
For: HARD CANDY WITH IMPROVED) Confirmation No.: 6889
STORAGE STABILITY)

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Commissioner for Patents
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Office Action mailed September 19, 2006, and pursuant to the OG Notice of July 12, 2005, regarding the Pre-Appeal Brief Conference Pilot Program, Applicants respectfully request panel review of the claims. A Notice of Appeal accompanies this Request. This Request is due December 19, 2006, and is timely filed.

REMARKS

Appellants have discovered that hard caramels containing certain limited concentrations of two ingredients, 1,1-GPM and sorbitol, have unexpectedly superior properties. Those properties, such as reduced water uptake, result in improved storage stability compared to hard caramels produced using concentrations of 1,1-GPM and sorbitol outside of the narrow concentration ranges recited. The Office has ignored this discovery, however, and Appellants respectfully traverse its rejection of the claims.

I. The Specification Fully Enables Claims 1-12

The Office rejects claims 1-12 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. (Office Action, page 2.) The entire substance of the Office's rejection is that "Applicant does not clearly teach what is encompassed by 'reduced water uptake.'" (*Id.*) Appellants respectfully traverse this rejection.

"The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." M.P.E.P. § 2164.04. Here, the Office fails to address any of the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988) and discussed in M.P.E.P. § 2164.01(a). Accordingly, it has not met its initial burden. Appellants again point out that the specification discloses that reduced water uptake is an indicator of improved stability in storage. (See, e.g., Specification, page 3, lines 1-8.) Appellants respectfully submit that the term "reduced water uptake" is reasonably clear. Further, the working examples provide methods for assessing whether water uptake is reduced. (See, e.g., Specification, pages 9-13.) Thus, the specification provides sufficient guidance so that one skilled in the art could determine without undue experimentation whether a hard caramel has reduced water uptake. Consequently, the rejection should be withdrawn.

II. **Claims 1-12 Are Patentable Under 35 U.S.C. § 103(a)**

Claims 1-12 also stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,578,339 to Kunz et al. ("Kunz") and U.S. Patent No. 6,248,386 to Willibald-Ettle et al. ("Willibald-Ettle"). (Office Action, page 3.) The Office asserts that "the amount employed are no matter [sic] than a matter of choice and well-within the skill of the art and at most are deemed optimization." (*Id.*)

The claims of *Kunz* relied upon by the Office recite a sweetener (e.g., claim 5) comprising 45% to 60% by weight of 1,1-GPM, or a candy comprising that sweetener (e.g., claim 21). Claim 8 of *Kunz* permits the sweetener to include "small amounts" of sorbitol or other sweeteners. *Kunz*, however, teaches that those other sweeteners including sorbitol are to be avoided because they yield products that are sticky. (*Kunz*, col. 1, lines 49-52.) *Willibald-Ettle* teaches hard caramels comprising 1,1-GPM and sorbitol, but does not specify their relative amounts. The Office acknowledges that "the claims differ as to the specific amounts employed," but finds that it would have been obvious "to use the claimed percentages in either *Kunz* et al or *Willibald-Ettle* et al because the use and manipulation of both 1,1-GPM and sorbitol are conventional in the production of hard candies such as caramels." (Office Action, page 3.)

The claims recite a particular type of candy, a hard caramel, containing not only a specific range of 1,1-GPM, but also a specific range of sorbitol by weight—0.5% to 3.5%. Neither reference provides any motivation to select the recited ranges of 1,1-GPM and sorbitol. Further, the Office does not provide any clear and particular reasons why the ordinary artisan would have been motivated to select the recited ranges for the production of a hard caramel. Because there is no motivation to combine the reference teachings, the Office has failed to establish a *prima facie* case for rejecting the claims.

It is only after the Office has established a *prima facie* case that Appellants have any obligation to provide evidence of nonobviousness, such as unexpected results. See M.P.E.P. § 2142. Nevertheless, as previously discussed, the Specification and two Rule 1.132 Declarations of record establish unexpected results. Furthermore, the references relied upon by the Office teach away from their combination.

Data in the Specification and two Rule 1.132 Declarations show that hard caramels containing 1,1-GPM and sorbitol in the recited ranges have unexpectedly superior properties. For example, the Specification's data discussed on pages 11-13 show that unwanted water intake depends upon both the 1,1-GPM and sorbitol concentration and that unwanted water intake is reduced when the 1,1-GPM and sorbitol are within the claimed concentration ranges. The August 10, 2006, Kowalczyk Declaration provided additional data showing that it is the combination of specific concentrations of 1,1-GPM with specific concentrations of sorbitol that results in hard caramels with the unexpected and advantageous property of reduced water uptake. (August 10, 2006, Kowalczyk Declaration, ¶12.) The unforeseeability of the effect on water uptake of combining specific amounts of 1,1-GPM and sorbitol is perhaps easiest to appreciate when one notes that the graph of water uptake shown in Figure 1 is not linear. (Kowalczyk Declaration, Exhibit 2.) Instead, when either 0.7% or 2.0% sorbitol are combined with varying concentrations of 1,1-GPM, there is an unexpected minimum that appears at the recited range of 1,1-GPM. (*Id.* at Figure 1.) As Dr. Kowalczyk noted, the unexpected minimum means that the observation is not mere optimization. (*Id.* at ¶14.) Reduced water uptake results in improved stability in storage, which has practical significance because it influences the marketability of the hard caramels.

Appellants have also pointed out in detail in previous responses that *Kunz* teaches that it is desirable to eliminate sorbitol from the sweetener and provides methods for removing the sorbitol from a sweetener. (See, for example, the Response filed November 28, 2005, pages 5-7.) *Kunz*, therefore, teaches away from a candy containing sorbitol and the ordinary artisan would avoid including sorbitol in the sweetener of *Kunz* to produce a hard caramel as taught by *Willibald-Ettle*.

For these reasons and those of record, Appellants respectfully maintain that the Office has failed to establish a *prima facie* case of obviousness at least because there is no motivation to combine the teachings of the references. Further, even if the Office had established a *prima facie* case, the unexpected results shown in the Specification and Rule 1.132 Declarations and the teaching away from the inclusion of sorbitol by Kunz would be sufficient to rebut it. Appellants therefore respectfully submit that the rejection is in error and request the Office to withdraw it.

Conclusion

In view of the foregoing remarks, Appellants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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Dated: December 4, 2006

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